

### **REMARKS**

The Office Action mailed April 30, 2003 has been carefully reviewed and, in view of the above amendments and following remarks, reconsideration and allowance of the application are respectfully requested.

#### **I. Summary of Rejections**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-3, 5, 14-15, 32-34, and 36-43 were rejected under 35 U.S.C. §102(b) as being anticipated by a PCT Application having International Publication Number WO 91/10376;
- Claims 1, 4, 5, 14-15, 32-34, 36, and 38-42 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Number 5,383,290 to Grim; and
- Claims 2, 4, 6-13, and 43 were rejected under 35 U.S.C. §103(a) as being unpatentable over either the PCT Application or Grim in view of U.S. Patent Number 5,313,717 to Allen et al.

In addition, the Examiner objected to the disclosure, including the Abstract, on various grounds, which were remedied by the above Amendments to the Specification.

#### **II. Summary of Claims**

Claims 1-14 and 16-70 are currently pending in the application, with claims 16-31, 35, and 44-57 being withdrawn from consideration. Claims 1, 14, 32, and 40 are currently amended, claim 15 is cancelled, and claims 58-70 are added, in accordance with the above Amendments to the Claims.

#### **III. The Claims Patentably Distinguish Over The Applied Prior Art**

##### ***The Claims Are Allowable Over The PCT Application***

The PCT Application discloses an article of footwear having an upper and a sole. One or more sacs are located within the sole, and one or more ducts extend from each sac. The ducts are positioned on an exterior of the upper, and the ducts are in fluid communication with the sacs. One-way valves may be positioned within the ducts to direct fluid flow. With regard to

manufacture of the footwear, "the sacs 24 and 30 are inserted in to the recesses 36 and 38 of the sole 12, the heel counter 16 and the forward counters 18 are then inserted in such a manner with the tubular ducts 20 and 22 are recessed in the channels 21 and 23 respectively, and then the remainder of the shoe upper is assembled..." (PCT Application, page 6, lines 3-9). Furthermore, "the valve body is inserted in to the tube 20..." (PCT Application, page 6, lines 24-25). Accordingly, the ducts are formed separate from the sacs and subsequently secured to the sacs during manufacture of the footwear, thereby permitting insertion of the valves. The separate nature of the ducts and sacs may also be determined with reference to Figures 2-5.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference (See MPEP §2131). Each of independent claims 1, 14, 32, and 40 recite that the sole portion and the foot portion are integral. For example, claim 1 recites "said foot portion in fluid communication and integral with said sole portion...", and claims 14, 32, and 40 each recite "a sole portion and an integral foot portion." As discussed above with respect to the PCT Application, the ducts are formed separate from the sacs and subsequently secured to the sacs during manufacture of the footwear. The PCT Application does not teach or suggest, therefore, an integral sole portion and foot portion, as recited in the claims.

Based upon the above discussion, independent claims 1, 14, 32, and 40 are allowable over the PCT Application. Furthermore, dependent claims 2-3, 5, 33-34, 36-39, and 41-43 are allowable for at least the same reasons.

#### *The Claims Are Allowable Over Grim*

Grim discloses an article of footwear having an upper and a sole. In one embodiment, the sole includes a bladder with zones that extend onto sides of the upper. The bladder is filled with material, such as small spherical particles. A vacuum pump is connected to the bladder and is actuated by running or walking to evacuate air from the bladder. Furthermore, a conduit having a valve is secured to the bladder to replenish the evacuated air. Accordingly, the footwear is structured to permit ambient air to enter the bladder.

Each of independent claims 1, 14, 32, and 40 recite that the bladder is sealed. For example, claim 1 recites "a resilient, sealed bladder for containing fluid...", and claims 14, 32, and 40 each recite a similar sealed configuration. As discussed above with respect to Grim, the